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[10191/1234]

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES**

Applicants : Dieter SCHULER et al.
Serial No. : 09/446,390
Filed : December 21, 1999
For : ELECTRICAL MACHINE HAVING A COMMUTATOR
Examiner : Dang D. LE
Art Unit : 2834
Conf. No. : 2255

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Date: 12/17, 2003 Reg. No. 36,197

Signature: [Signature]
Jong H. Lee

**APPELLANTS' REPLY BRIEF IN RESPONSE TO
EXAMINER'S ANSWER (UNDER 37 C.F.R. § 1.193)**

S I R :

In response to the Examiner's Answer mailed on October 22, 2003 regarding the above-identified application, Applicants submit the following arguments in support of the appeal of the final rejection.

RELATED APPEALS AND INTERFERENCES

The Examiner's Answer indicates that Applicants' Appeal Brief does not contain a statement identifying the related appeals and interferences. However, Applicants' Appeal Brief clearly indicated that "[n]o appeal or interference which will directly affect, or be directly affected by, or have a bearing on the

Board's decision in the pending appeal is known to exist to the undersigned attorney or is believed by the undersigned attorney to be known to exist to Applicants."

ARGUMENTS

A. Rejection of Claims 15, 20, 21 and 24

The Examiner has rejected claims 15, 20, 21 and 24 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 2,172,045 to ("Burr et al.") It is respectfully submitted that this rejection should be reversed for the following reasons.

In the Examiner's Answer, the Examiner makes the following statements:

The Examiner agrees that the channels in the present application are open before filled up with oil and after the oil is used up. However, claims 15, 20, 21, and 24 are open-ended claims and do not particularly point out and distinctly claim the subject matter. They neither specify that the channels [are] open the entire life of the brush after being filled with lubricant. In other words, the claims do not clearly state when the channels are open. (Examiner's Answer, page 13, third paragraph).

Applicants note two major errors in the Examiner's arguments. First, the fact that claims 15, 20, 21 and 24 are "open-ended" claims has absolutely no relevance to how the recited elements should be interpreted. To the extent the Examiner is arguing that explicitly recited structural elements of claims 15, 20, 21 and 24, e.g., "the plurality of channels along the collector end face are open at each end along the collector end face" as recited in claim 15, may be interpreted as if they did not exist (simply because elements not explicitly recited may theoretically affect the structure of the explicitly recited element), is completely incorrect as a matter of law. To reject a claim under 35 U.S.C. § 102(b), the Office must demonstrate the presence in a single prior art reference disclosure of each and every element of the claim invention, *arranged as in the claim*. See Lindeman

Machinenfabrik v. American Hoist and Derrick, 730 F.2d 1452, 1458 (Fed. Cir. 1984). There is no disclosure in Burr that the plurality of channels (31) along the collector end face (30) are open at each end along the collector end face (30), as recited in claims 15 and 20 of the present application. In fact, Burr clearly teaches away from Applicants' invention: in column 1, lines 30-33, it is indicated that the filler material is "**permanently secured** in a recess formed in the brush body," and that "it is preferred to locate the strips close to opposite edges of the working face of the brush, since this arrangement of the lubricating strips tends to provide a smoother riding brush." (See column 4, lines 2-6). Furthermore, Burr clearly indicates that slots or recesses 2 are filled with a plastic heat-hardenable composition 3, which is **baked to solid state and integrally united to the body** of the brush 1, i.e., the **slots or recesses are not open**.

Independent of the above, Applicants note that the Examiner's argument that "claims 15, 20, 21, and 24 . . . do not particularly point out and distinctly claim the subject matter" is not a relevant consideration under 35 U.S.C. § 102(b) anticipation rejection; instead, the Examiner's argument raises considerations under 35 U.S.C. § 112 indefiniteness rejection, which has not been raised by the Examiner in the final rejection of January 3, 2003, and which is not an issue under consideration in the present appeal. Applicants note that raising a new ground of rejection is prohibited under 37 C.F.R. § 1.193(a)(2). In any case, Applicants respectfully submit that there is nothing indefinite about "the plurality of channels along the collector end face are open at each end along the collector end face" as recited in claim 15, and as similarly recited in claim 20. The plain meaning of the claimed limitation is clear on its face, and the specification completely supports the plain meaning: the channels are open, i.e., enables passage of material (e.g., oil lubricant) through the channels, at all times. In other words, the claimed channels are **structurally "open" at all times**, even if oil is present some of the time (since the ingress and egress of oil wouldn't be possible if the channels weren't "open"). The key distinction between the Applicants' claimed invention and the arrangement disclosed in Burr is that the present

invention provides a **structural opening**, i.e., the channels are open, whereas Burr clearly indicates that slots or recesses 2 are filled with a plastic heat-hardenable composition 3, which is **baked to solid state and integrally unit d to th body** of the brush 1, i.e., the **slots or recesses are closed in permanent state**.

To the extent the Examiner argues that the term “open” also means “being porous and friable” (citing Merriam Webster’s Collegiate Dictionary (10th Edition)), Applicants note that this asserted definition is the 11th definition offered for the term “open,” and this asserted definition is offered in the context of defining the phrase “open soil.” Applicants submit that the Examiner’s asserted definition is clearly inapplicable to the claimed invention which includes a structural open channel, since the pending claims must be “given the broadest reasonable interpretation **consistent with the specification**.” MPEP 2111. In addition, the broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach. MPEP 2111. It is simply untenable to argue that one of ordinary skill in the art reading (with the aid of the Applicants’ specification) the claimed limitation “the plurality of channels along the collector end face are open” would conclude that this limitation encompassed Burr’s slots 2 filled with a plastic heat-hardenable composition 3 which is **bak d to solid state and integrally united to the body** of the brush 1.

For the foregoing reasons, Burr does not anticipate the subject matter of Claims 15 and 20. Claims 21 and 24 depend from, and include all the limitations of, Claims 20 and 15, respectively, and therefore Claims 21 and 24 are also not anticipated by Burr. Reversal of the anticipation rejection of Claims 15, 20, 21 and 24 is hereby respectfully requested.

B. Rejection of Claims 6, 10, 11 14, 16, 19, 22 and 23

Claims 6, 10, 11, 14, 16, 19, 22 and 23 stand rejected under 35 U.S.C. § 103 (a) as being unpatentable over Burr (U.S. Patent No. 2,172,045) in view of

Portail (U.S. Patent No. 2,555,997). Applicants respectfully submit that this rejection should be reversed for at least the following reasons.

Independent Claim 6 recites “at least one brush; . . . and a supply of oil lubricant . . . , wherein the at least one brush contains the lubricant at least one of: (a) in or on a collector-side end face of the at least one brush, and (b) in or on a partial length of the at least one brush beginning at the collector-side end face of the at least one brush, wherein the brush has a plurality of grooves along the collector-side end face and wherein the grooves are open at each end along the collector-side end face.” Independent Claim 10 recites “an end face; and a supply of oil lubricant in an area of the end face . . . , wherein the brush has a plurality of grooves along the collector end face and wherein the grooves are open at each end along the collector end face.”

In the Examiner’s Answer, the Examiner contends that there is a motivation to combine the teachings of Burr with the teachings of Portail: Burr teaches soft insert material 3, and “the liquid used by Portail is very soft.” Applicants respectfully submit that this rationale is untenable, since the proposed modification would render both the invention of Burr as well as the invention of Portail unsatisfactory for their intended purposes, which defeats the obviousness conclusion, as a matter of law. See MPEP 2143.01. Applicants note that Burr teaches the use of a filler material that is “permanently secured in a recess formed in the brush body, (see column 1, lines 30-33), while Portail teaches the use of brushes through which thin film (11) that can be fed through (see column 4, lines 13-15). It is clear that a thin film (11) of Portail cannot be permanently secured to the recesses (2) of Burr, and the permanently securable filler material (3) of Burr cannot be fed through the brush (2) of Portail. Accordingly, the proposed modification would render both the invention of Burr as well as the invention of Portail unsatisfactory for their intended purposes. If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed

modification. In re Gordon, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984). Since the proposed modification would render both the invention of Burr as well as the invention of Portail unsatisfactory for their intended purposes, there is clearly no motivation to make the asserted combination.

For the foregoing reasons, independent claims 6 and 10 are allowable over the combination of Burr and Portail. Claims 11, 14, 16, 19, 22 and 23 depend from, and include all the limitations of, claim 10 or claim 6, so claims 11, 14, 16, 19, 22 and 23 are similarly allowable over the combination of Burr and Portail. Reversal of the obviousness rejection of claims 6, 10, 11 14, 16, 19, 22 and 23 is respectfully requested.

C. Rejection of Claims 12 and 17

Claims 12 and 17 stand rejected under 35 U.S.C. § 103 (a) as being unpatentable over Burr (U.S. Patent No. 2,172,045) in view of Portail (U.S. Patent No. 2,555,997) and further in view of Grunewald et al. (U.S. Patent No. 3,841,906). Since the Examiner does not provide any additional substantive arguments in the Examiner's Answer in support of this rejection, Applicants respectfully submit that this rejection should be reversed for the reasons stated in the Applicants' Appeal Brief.

D. Rejection of Claims 13 and 18

Claims 13 and 18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Burr (U.S. Patent No. 2,172,045) in view of Portail (U.S. Patent No. 2,555,997) and further in view of Rogelein et al. (U.S. Patent No. 4,820,948). Since the Examiner does not provide any additional substantive arguments in the Examiner's Answer in support of this rejection, Applicants respectfully submit that this rejection should be reversed for the reasons stated in the Applicants' Appeal Brief.

E. Rejection of Claims 6, 10, 11, 14-16 and 19-24

Claims 6, 10, 11, 14-16 and 19-24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,909,077 to Bruhn (the “Bruhn” reference) in view of Portail. Applicants respectfully submit that this rejection should be withdrawn for at least the following reasons.

In the Examiner’s Answer, the Examiner contends that since “Portail adds the oil for the purpose of reducing wear and smooth operation while Bruhn provides the grooves in order to reduce noise,” “providing grooves on the contact surface of the brushes (2) of Portail would reduce noise,” and “adding oil to the brushes or the commutators of Bruhn will reduce wear as taught by Portail.” However, this argument completely ignores the fact that the intended purposes of Bruhn and Portail are not only fundamentally different from one another, but also fundamentally different from the claimed invention. The purpose for the grooves in Bruhn is abrasion resistance and noise reduction. (See Abstract of Bruhn). In contrast, the object of Portail is to provide “improved sliding and rotating contacts for electric machines, and in particular commutators and brushes cooperating with these commutators.” (Column 1, lines 14-17). **Since the grooves of Bruhn serve a different purpose than the oil lubricant of Portail, there is simply no motivation to combine the oil lubricant with the grooves.** Furthermore, there is no teaching or suggestion in either Bruhn or Portail regarding the reduction of the deleterious presence of oil lubricant in the electric machine, or of lowering the risk of conducting parasitic currents, as described in the present application. (See specification at page 3, lines 15-23).

For the foregoing reasons, the combination of the applied references fails to support a *prima facie* case of obviousness, and independent claims 6, 10, 15 and 20 are allowable over the combination of Bruhn and Portail. Claims 11, 14, 16, 19, 21, 22 and 23 depend from, and include all the limitations of, of claims 6, 10, 15 or 20, and therefore Claims 11, 14, 16, 19, 21, 22 and 23 are similarly allowable over the combination of Bruhn and Portail. Reversal of the obviousness

rejection claims 6, 10, 11, 14-16 and 19-24 is hereby respectfully requested.

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Claims 12 and 17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Bruhn in view of Portail and further in view of Grunewald. Since the Examiner does not provide any additional substantive arguments in the Examiner's Answer in support of this rejection, Applicants respectfully submit that this rejection should be reversed for the reasons stated in the Applicants' Appeal Brief.

G. Rejection of Claims 13 and 18

Claims 13 and 18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Bruhn in view of Portail and further in view of Rogelein. Since the Examiner does not provide any additional substantive arguments in the Examiner's Answer in support of this rejection, Applicants respectfully submit that this rejection should be reversed for the reasons stated in the Applicants' Appeal Brief.

CONCLUSION

For the preceding reasons, it is respectfully submitted that the final rejections of claims 6 and 10-24 should be reversed.

Respectfully submitted,

KENYON & KENYON

Dated: 12/17, 2003

By: for Richard L. Mayer (by John R. No. 26,197)

Richard L. Mayer
Reg. No. 22,490

CUSTOMER NO.6646
PATENT TRADEMARK OFFICE



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Applicants note two major errors in the Examiner's arguments. First, the fact that claims 15, 20, 21 and 24 are "open-ended" claims has absolutely no relevance to how the recited elements should be interpreted. To the extent the Examiner is arguing that explicitly recited structural elements of claims 15, 20, 21 and 24, e.g., "the plurality of channels along the collector end face are open at each end along the collector end face" as recited in claim 15, may be interpreted as if they did not exist (simply because elements not explicitly recited may theoretically affect the structure of the explicitly recited element), is completely incorrect as a matter of law. To reject a claim under 35 U.S.C. § 102(b), the Office must demonstrate the presence in a single prior art reference disclosure of each and every element of the claim invention, *arranged as in the claim*. See Lindeman

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invention provides a **structural opening**, i.e., the channels are open, whereas Burr clearly indicates that slots or recesses 2 are filled with a plastic heat-hardenable composition 3, which is **baked to solid state and integrally united to the body** of the brush 1, i.e., the **slots or recesses are closed in permanent state**.

To the extent the Examiner argues that the term "open" also means "being porous and friable" (citing Merriam Webster's Collegiate Dictionary (10th Edition)), Applicants note that this asserted definition is the 11th definition offered for the term "open," and this asserted definition is offered in the context of defining the phrase "open soil." Applicants submit that the Examiner's asserted definition is clearly inapplicable to the claimed invention which includes a structural open channel, since the pending claims must be "given the broadest reasonable interpretation **consistent with the specification**." MPEP 2111. In addition, the broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach. MPEP 2111. It is simply untenable to argue that one of ordinary skill in the art reading (with the aid of the Applicants' specification) the claimed limitation "the plurality of channels along the collector end face are open" would conclude that this limitation encompassed Burr's slots 2 filled with a plastic heat-hardenable composition 3 which is **baked to solid state and integrally united to the body** of the brush 1.

For the foregoing reasons, Burr does not anticipate the subject matter of Claims 15 and 20. Claims 21 and 24 depend from, and include all the limitations of, Claims 20 and 15, respectively, and therefore Claims 21 and 24 are also not anticipated by Burr. Reversal of the anticipation rejection of Claims 15, 20, 21 and 24 is hereby respectfully requested.

B. Rejection of Claims 6, 10, 11, 14, 16, 19, 22 and 23

Claims 6, 10, 11, 14, 16, 19, 22 and 23 stand rejected under 35 U.S.C. § 103 (a) as being unpatentable over Burr (U.S. Patent No. 2,172,045) in view of

Portail (U.S. Patent No. 2,555,997). Applicants respectfully submit that this rejection should be reversed for at least the following reasons.

Independent Claim 6 recites “at least one brush; . . . and a supply of oil lubricant . . . , wherein the at least one brush contains the lubricant at least one of: (a) in or on a collector-side end face of the at least one brush, and (b) in or on a partial length of the at least one brush beginning at the collector-side end face of the at least one brush, wherein the brush has a plurality of grooves along the collector-side end face and wherein the grooves are open at each end along the collector-side end face.” Independent Claim 10 recites “an end face; and a supply of oil lubricant in an area of the end face . . . , wherein the brush has a plurality of grooves along the collector end face and wherein the grooves are open at each end along the collector end face.”

In the Examiner’s Answer, the Examiner contends that there is a motivation to combine the teachings of Burr with the teachings of Portail: Burr teaches soft insert material 3, and “the liquid used by Portail is very soft.” Applicants respectfully submit that this rationale is untenable, since the proposed modification would render both the invention of Burr as well as the invention of Portail unsatisfactory for their intended purposes, which defeats the obviousness conclusion, as a matter of law. See MPEP 2143.01. Applicants note that Burr teaches the use of a filler material that is “permanently secured in a recess formed in the brush body, (see column 1, lines 30-33), while Portail teaches the use of brushes through which thin film (11) that can be fed through (see column 4, lines 13-15). It is clear that a thin film (11) of Portail cannot be permanently secured to the recesses (2) of Burr, and the permanently securable filler material (3) of Burr cannot be fed through the brush (2) of Portail. Accordingly, the proposed modification would render both the invention of Burr as well as the invention of Portail unsatisfactory for their intended purposes. If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed

modification. In re Gordon, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984). Since the proposed modification would render both the invention of Burr as well as the invention of Portail unsatisfactory for their intended purposes, there is clearly no motivation to make the asserted combination.

For the foregoing reasons, independent claims 6 and 10 are allowable over the combination of Burr and Portail. Claims 11, 14, 16, 19, 22 and 23 depend from, and include all the limitations of, claim 10 or claim 6, so claims 11, 14, 16, 19, 22 and 23 are similarly allowable over the combination of Burr and Portail. Reversal of the obviousness rejection of claims 6, 10, 11 14, 16, 19, 22 and 23 is respectfully requested.

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Claims 12 and 17 stand rejected under 35 U.S.C. § 103 (a) as being unpatentable over Burr (U.S. Patent No. 2,172,045) in view of Portail (U.S. Patent No. 2,555,997) and further in view of Grunewald et al. (U.S. Patent No. 3,841,906). Since the Examiner does not provide any additional substantive arguments in the Examiner's Answer in support of this rejection, Applicants respectfully submit that this rejection should be reversed for the reasons stated in the Applicants' Appeal Brief.

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For the foregoing reasons, the combination of the applied references fails to support a *prima facie* case of obviousness, and independent claims 6, 10, 15 and 20 are allowable over the combination of Bruhn and Portail. Claims 11, 14, 16, 19, 21, 22 and 23 depend from, and include all the limitations of, of claims 6, 10, 15 or 20, and therefore Claims 11, 14, 16, 19, 21, 22 and 23 are similarly allowable over the combination of Bruhn and Portail. Reversal of the obviousness

rejection claims 6, 10, 11, 14-16 and 19-24 is hereby respectfully requested.

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Claims 12 and 17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Bruhn in view of Portail and further in view of Grunewald. Since the Examiner does not provide any additional substantive arguments in the Examiner's Answer in support of this rejection, Applicants respectfully submit that this rejection should be reversed for the reasons stated in the Applicants' Appeal Brief.

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CONCLUSION

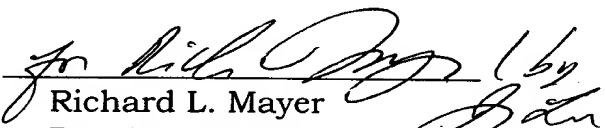
For the preceding reasons, it is respectfully submitted that the final rejections of claims 6 and 10-24 should be reversed.

Respectfully submitted,

KENYON & KENYON

Dated: 12/17, 2003

By:


Richard L. Mayer
Reg. No. 22,490

CUSTOMER NO.6646
PATENT TRADEMARK OFFICE

Handwritten: R. No. 26,197)